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C. REMARKS

Claims 1-27 are pending in the present application. Claims 3, 5, 6, 8, 11, 12, 14-16, 18, 22, 24, and 25 were objected to by the Examiner, but found to be otherwise allowable. No claims were amended or cancelled in this Response. Reconsideration of the rejected claims is respectfully requested.

Improper Finality of Rejection

Applicants respectfully direct the Office's attention to Section 706.07(a) of the Manual of Patent Examining Procedure, edition 8, revision 1, which, *inter alia*, states:

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). . . . Furthermore, a second or any subsequent action on the merits in any application or patent undergoing reexamination proceedings will not be made final if it includes a rejection, on newly cited art, other than information submitted in an information disclosure statement filed under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17 (p), of any claim not amended by applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art.

Applicants respectfully submit that although Applicants have not amended any of the claims in any previous amendment, the Examiner has cited new art in the rejections of claims 2 and 21, namely patent document US 5574774 (AHLBERG ET AL.) NOV 12, 1996. MPEP § 706.07(a), recited above, states that under current Office practice, a second or subsequent action on the merits WILL NOT BE MADE FINAL if it includes any rejection that is based on newly cited art and not necessitated by the amendment of the rejected claim(s). In the present application *no claims have ever been amended* by Applicants. Thus, Applicants respectfully submit that the Office Action of November 4, 2003 to which this Response is made, should not have been made final, in light of present Office practice. Applicants therefore respectfully request that finality of the Office Action be withdrawn so as to comply with present PTO standards of practice.

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35 U.S.C. § 102, Anticipation

Claims 1, 4, 7, 9, 13, 17, 19, 20, 23, 26, and 27 were rejected under 35 U.S.C. § 102 as being anticipated by US 5463625 (YASREBI) OCT 31, 1995. The rejection is respectfully traversed.

Specifically, the Examiner stated:

As to claim 1, Yasrebi teaches method comprising: receiving a close request (prior to put to sleep); and setting the adapter to a quasi-open state (put to sleep mode) in response to receiving the close request (col. 10, lines 52-64).

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). YASREBI fails to anticipate the presently claimed invention because it fails to show all of the elements of the claimed invention.

The rejected claims, whether independently or through dependency, all recite a feature of setting an adapter to a quasi-open state in response to receiving a close request. This feature is not taught by YASREBI.

The cited portion of YASREBI, relied upon by the Examiner in support of the rejection, describes using *threads* in a software process in order to *simulate* devices in a network:

The procedure call for each PortOpen command 67 issued by the client to the gateway server actually called a previously generated procedure stub. The call returned a handle from the server. The client then issued a Connect(out) 68 to the gateway that returned when a simulated successful outgoing call was established. The procedure call thread was then "put to sleep" for a random period of time 69 (to simulate random connection time between the LAN workstation application and a remote server), after which Disconnect and PortClose commands 70 and 71 were sequentially issued with the same handle before the thread was terminated 72. [col. 10, lines 52-64].

The Examiner has interpreted putting a thread to sleep as encompassing placing an adapter in a quasi-open state. Applicants respectfully disagree with this interpretation. Notwithstanding the fact that YASREBI teaches a software *simulation* of network devices, which is, on its face, distinct from the present claims' recitation placing an actual adapter in a quasi-open state, there are a number of clear differences between what is taught in YASREBI and what is recited in Applicants' claims such that even given the Examiner's broad reading of the rejected

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independent claims, YASREBI still fails to teach all of the elements of the presently rejected claims.

Firstly, the Examiner has failed to show that putting a thread to sleep is equivalent to placing an adapter in a quasi-open state. Even if one could make the argument that a thread that is intended to simulate a network device could be considered an "adapter," the Examiner has still failed to demonstrate that YASREBI's teaching of putting the thread to sleep even simulates a quasi-open state. A "quasi-open" state, as the name implies, is a state that resembles an open state in some respects, but is not actually an open state. The specification describes this as follows:

When a close request is received by the adapter, the adapter enters a quasi-open state rather than actually closing the adapter. The quasi-open state keeps the link between the adapter and the Fibre Channel network open by maintaining a minimal set of resources. Extended resources, needed to operate in open mode, are released. [p. 14, lines 6-11].

Thus, a "quasi-open" state is a third kind of state, distinct from both an open state and a closed state. YASREBI fails to describe any such kind of third state. The above excerpt from YASREBI states that a thread is placed to sleep for a period of time to simulate random-length periods of connection between a workstation application and a server. YASREBI does not state or even imply that such a period is a "quasi-open" as opposed to an "open" state of connection; it simply states that that time period simulates a period of connection, without regard to what kind of connection is being simulated.

However, even if one skilled in the art could reasonably conclude that a sleeping thread simulating a connected network device could be considered an adapter in a quasi-open state, there is an even more compelling reason why YASREBI fails to teach all of the elements of the presently claimed invention, as argued by the Examiner. The cited excerpt relied upon by the Examiner as teaching Applicants' claimed feature of setting an adapter to a quasi-open state in response to receiving a close request actually describes something that is entirely incompatible with that teaching.

The Examiner asserts that putting a thread to sleep, as described in YASREBI, constitutes setting an adapter to a quasi-open state. The presently rejected claims, however, recite setting an adapter to a quasi-open state *in response to receiving a close request*. Thus, even if one could

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interpret a "quasi-open" state of an adapter as encompassing a sleeping thread, YASREBI would still fail to anticipate the presently claimed invention, because YASREBI fails to teach putting the thread to sleep *in response to receiving a close request*. Indeed, YASREBI not only fails to teach this claimed limitation, but YASREBI actually describes the complete opposite.

According to the above excerpt from YASREBI, upon which the entirety of Examiner's rejection is based, the close request (or PortClose command, as it is referred to in YASREBI) occurs only *after* the thread has been put to sleep. Thus, one skilled in the art would not—in fact, *could not*—reasonably interpret the act of putting a thread to sleep in above YASREBI excerpt as encompassing the claimed feature of setting an adapter to a quasi-open state in response to receiving a close request, the act of putting a thread to sleep in YASREBI is clearly *not* performed in response to receiving a close request. Hence, YASREBI not only fails to anticipate the presently claimed invention; if one assumes that putting a thread to sleep in YASREBI constitutes setting an adapter in a quasi-open state, then one must conclude that YASREBI actually teaches away from the presently claimed invention, as it is impossible to put a thread to sleep in response to a close request *before* the close request even occurs.

Therefore, Applicants respectfully submit that YASREBI fails to anticipate claims 1, 4, 7, 9, 13, 17, 19, 20, 23, 26, and 27, as the claimed feature of setting an adapter in a quasi-open state in response to receiving a close request, which is incorporated into all of these claims, is neither taught nor suggested by the YASREBI reference. Accordingly, Applicants respectfully request that claims 1, 4, 7, 9, 13, 17, 19, 20, 23, 26, and 27 be allowed.

35 U.S.C. § 103, Obviousness

The Examiner rejected claims 2 and 21 under 35 U.S.C. § 103 in view of YASREBI and US 5574774 (AHLBERG ET AL.) NOV 12, 1996 and also rejected claim 10 under 35 U.S.C. § 103 in view of YASREBI and US 6038235 (HO ET AL.) MAR 14, 2000. These rejections are respectfully traversed.

Claims 2 and 21 are dependent claims that depend on independent claims 1 and 20. Applicants have already demonstrated claims 1 and 20 to be in condition for allowance. Applicants respectfully submit that claims 2 and 21 are allowable for the same reasons provided in support of claims 1 and 20 above, at least by virtue of their dependency on those allowable

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claims. Moreover, the AHLBERG reference fails to cure the deficiencies of YASREBI with respect to the rejections of claims 1 and 20. AHLBERG does not recognize a third adapter state (*i.e.*, a "quasi-open" state) that is distinct from an open state and a closed state. Hence, AHLBERG, whether considered individually or in combination with the cited YASREBI reference, also fails to teach or suggest the features of claims 2 and 21. In addition, as discussed at length above, this Office Action is the first action in which a citation to the AHLBERG reference appears. Therefore, it is improper, under MPEP 706.07(a), for this Office Action to be made Final with respect to Claims 2 and 21. Accordingly, Applicants respectfully request the withdrawal of the finality of this Office Action.

Claim 10 is an independent claim, but as it recites the same feature of setting an adapter in a quasi-open state in response to receiving a close request, it is also patentable over the prior art of record for the same reasons set forth with respect to the other independent claims, claims 1 and 20. Moreover, the HO reference fails to cure the deficiencies of YASREBI with respect to the rejections of claims 1, 10, and 20. While HO "relates generally to methods and apparatus for data communication on a fiber channel loop" (col. 1, lines 32-46), HO fails to teach or suggest the critical feature of setting an adapter in a quasi-open state in response to receiving a close request.

For the foregoing reasons, Applicants respectfully submit that claims 2, 10, and 21 are patentable over the prior art of record and respectfully request that claims 2, 10, and 21 be allowed.

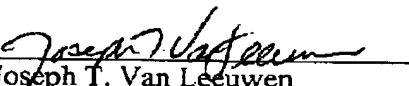
Conclusion

As a result of the foregoing, it is asserted by Applicants that all pending claims in the Application are in condition for allowance, and Applicants respectfully request allowance of such claims.

Applicants respectfully request that the Examiner contact the Applicants' attorney listed below if the Examiner believes that such a discussion would be helpful in resolving any remaining questions or issues related to this Application.

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